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09/575,150	05/23/2000	Paul Lapstun	NPK004US	9212
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SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			SHIN, KYUNG H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,150

Applicant(s)

LAPSTUN ET AL.

Examiner

Kyung H. Shin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7,8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed on 7/6/2005.
2. **Claims 1-5, 7, 8, 10-17** are pending. Independent claim is 1.

### ***Response to Arguments***

3. Applicant's arguments filed 7/6/2005 have been fully considered but they are not persuasive.

- 3.1 The Goffinet prior art discloses a control panel for configuration parameter access (i.e. standard control panel functions, setup and retrieval of configuration parameters). (see Goffinet col. 5, lines 3-7) As the applicant remarked, all configuration parameters would not be displayed at the control panel (Remarks Page 3, Lines 1-2), but configuration parameters which enable printer operation (i.e. access parameter, authorization identifier) are displayed and modifiable. Goffinet discloses providing to a user access parameters (i.e. authorization identifier) for a printer. Retrieval and manipulation of configuration parameters (i.e. standard operations) via printer's control panel is inherent in Goffinet. (see Goffinet col. 6, lines 49-54: configuration parameters manipulated (i.e. retrieved and modified))

The Goffinet prior art clearly states that both options, manual setup and remote setup, are implemented. (see Goffinet col. 6, lines 28-31; col. 11, line 66 - col. 12, line 1) Therefore, the Goffinet prior art does not teach away from

manual access to control a printer. Clearly, it is advantageous to remotely access a printer to obtain and modify configuration information (i.e. an authorization identifier) than it is to physically go to that printer to obtain and modify configuration information (i.e. an authorization identifier) as stated in applicant claims.

Applicant states that an embodiment of the invention allows a connection to a host computer for the display and modification of printer configuration parameter (Remark Page 3, Lines 37-39). The Goffinet prior art discloses this host computer system with attached printer operational configuration for printer setup, retrieval, modification of printer configuration information. (see Goffinet col. 6, lines 44-54)

- 3.2 In reply to an obviousness rejection under 35 U.S.C. § 103, applicant argues that the secondary and primary reference combination fails to disclose claim limitations and is not allowed due to nonobviousness and lack of motivation. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references

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individually where rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 - 5, 7, 8, 10 - 17** are rejected under 35 U.S.C.103(a) as being unpatentable over **Eldridge et al.** (U.S. Patent No. 6,515,988) in view of **Goffinet et al.** (U.S. Patent No. 5,715,403).

**Regarding Claim 1** (Currently Amended), Eldridge discloses a network connected to a printer, a first server, and a network terminal, a network terminal authorization method for authorizing the printing of a document at the printer at the request of the network terminal, including the steps of:

b) allocating, at the first server, the authorization identifier; (see Eldridge col. 5, line 65 - col. 6, line 1: authorization information exists at the server system)

d) receiving, at the first server, an authorization request from the network terminal containing the authorization identifier and the printer identifier, whereby the user

of the network terminal proves physical access to the printer because the user obtained the printer identifier through physical access to the printer, thus increasing printer security; (see Eldridge col. 5, line 65 - col. 6, line 1: authorization information at the server system to process documents)

- e) validating, at the first server, the authorization request; (see Eldridge col. 9, lines 53-60: verify and process a document from a first server)
- f) creating, at the first server, an authorization record authorizing the network terminal to print at the printer (see Eldridge col. 7, lines 1-16),
- g) requesting, at the network terminal, via a printing request, printing of the document at the printer; (see Eldridge col. 8, lines 62-66)
- h) verifying, using the authorization record, that the network terminal is authorized to print at the printer (see Eldridge col. 9, lines 18-22), and that the authorization record contains the same printer identifier as the printing request; (see Eldridge col. 6, lines 5-10; col. 6, lines 48-49: *"Authorization--The general token 30 includes ... the two main security components. It provides the means by which the system can verify that the token is genuine and has not been tampered with. The first security component is an Authorizer Identifier 342-- ... indicates the person that created the token 30. ... The Authorization identifier 342 may be ... as complex as a full X.509 identity certificate (see ITU-T Recommendation X.509--CCITT document 'The Directory-Authentication Framework'). The second security component is an Authorizer Digital Signature 344, ... a hash of the string using any suitable well-known secure hash function (e.g. MD5, SHA; see Applied*

*Cryptography by Bruce Schneier, 1996, John Wiley and Sons), and (c) encrypt the hash with the user's private key, “)*

- i) in the event that the verification succeeds, allowing the document to be printed at the printer. (see Eldridge col. 9, line 35; col. 5, line 65 - col. 6, line 10: “ A token contains ... essential information which allows the system (token-capable server software resident on public networks and private networks) to initiate actions which produce the desired result. For example, printing out a document only needs a simple interaction: The document's token is selected ... . When the latter token is received by the server software ... , the servers acts on the receipt of the token and causes the document to be retrieved, processed, and printed. “

Tokens are used as security and authentication devices and control the locating and access (host location), transfer (if necessary) and processing (printing) of documents.)

Eldridge discloses a mechanism for accessing electronic documents within a network connected document repository for printing. (see Eldridge col. 2, lines 10-17: “ ... information necessary to access documents, to invoke a document services with appropriate parameter settings, or to initiate the actions of a document device ... security information which provides safeguards to ensure that unauthorized use of the documents or document services that are referenced ... “)

Eldridge does not disclose obtaining authentication information at a printer.

However, Goffinet discloses:

- a) receiving, at the printer and at the first server, an authorization identifier request requesting the allocation of an authorization identifier; (see Goffinet col. 6, lines 28-31; col. 11, line 66 - col. 12, line 1: obtain at printer from printer control panel printer name (i.e. printer identifier) and printer access password (i.e. authorization information) for local and network (i.e. remote) access to printer ; col. 9, lines 22-22; col. 9, lines 42-43; col. 9, lines 59-59: printer name (i.e. printer identifier), password information (i.e. authorization identifier))
- c) providing to a user, at the printer, the authorization identifier and the printer identifier; (see Goffinet col. 6, lines 28-31; col. 11, line 66 - col. 12, line 1: obtain at printer, from printer control panel, printer name (i.e. printer identifier) and printer access password (i.e. authorization information) for local and network (i.e. remote) access to printer ; col. 9, lines 22-22; col. 9, lines 42-43; col. 9, lines 59-59: printer name (i.e. printer identifier), password information (i.e. authorization identifier))

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to obtain printer identification and authorization information based on physical (i.e. manual access to printer's control panel) access to a printer's configuration information as taught by Goffinet. One of ordinary skill in the art would be motivated to employ Goffinet in order to optimize configuration and setup for multiple printers with local and



remote access within a network environment. (see Goffinet col. 1, lines 41-47: “  
... *provide a networked system that includes a host computer and multiple  
printers in which the printers are capable of allowing the host computer to easily  
and accurately setup one or more of the printers connected to the network ...*”)

**Regarding Claim 2 (Currently Amended)**, Eldridge discloses a method according to claim 1, where, in the requesting step, the printing request is sent to the first server, and the verifying and sending steps are performed at the first server. (see Eldridge col. 5, line 65 - col. 6, line 10: A network can contain multiple server (i.e. first server, second server,..., ) with token server software installed, token server software system controls access and processing of documents based on information contained within token and server system)

**Regarding Claim 3 (Currently Amended)**, Eldridge discloses a method according to claim 1, where, in the requesting step, the printing request is sent to a second server and the sending step is performed at the second server; the verifying step including the sub-steps of: (see Eldridge col. 9, lines 13-21)

- a) requesting, at the second server and via a verification request sent to the first server, verification; (see Eldridge col. 9, lines 29-37)
- b) verifying, at the first server and in response to the verification request, that the network terminal is authorized to print at the printer. (see Eldridge col. 9, lines 53-

60: A "second" token software enabled server must receive a token to receive, verify and process a document (retrieve and/or print) from a first server that received a token to process a document)

**Regarding Claim 4 (Currently Amended)**, Eldridge discloses a method according to claim 2 or claim 3, including the further steps of:

- a) allocating, at the network terminal, a public/private signature key pair; (see Eldridge col. 2, lines 47-56)
- b) storing, at the network terminal, the private signature key; (see Eldridge col. 7, lines 13-15) and
- c) storing, at the first server and as part of the authorization record, the public signature key. (see Eldridge col. 2, lines 64-67: *" The security information includes a digital signature of the information in the token. The digital signature is a digest of information in the token and its encryption with the document owner's private key. This follows well known prior cryptographic art relating to public/private key cryptography (see U.S. Pat. No. 4,405,829). "* PKI technology is used in the implementation of security and authentication for access at a network terminal)

**Regarding Claim 5 (Currently Amended)**, Eldridge discloses a method according to claim 4, where the requesting step includes the sub-step of generating a digital signature using the private key (see Eldridge col. 2, lines 47-50) and attaching it to the

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request (see Eldridge col. 7, lines 43-54), and the verification step includes the sub-step of verifying the digital signature attached to the request using the public key. (see Eldridge col. 3, lines 11-19: “ *Tokens which include security information are presented to "secure documents servers". A secure server contains a "gatekeeper" which verifies signatures on tokens and examines the specified conditions ... (e.g. encrypting the document with the appropriate key). The public key for verifying the signature is obtained through a parameter in the security information which identifies the owner of the document ....* ” Digital signature technology is used in the implementation of security for access file server (document retrieval and transmittal) and/or print server (document formatting and printing) system. )

**Regarding Claim 7** (Currently Amended), Eldridge discloses a method according to claim 1, where the creating step includes the sub-steps of:

- a) allocating a terminal identifier for the network terminal; (see Eldridge col. 6, lines 48-62: “ *The general token 30 includes a Service Host Identifier 32 which identifies a host machine on a network....* ” The network address (equivalent to terminal identifier) indicates the network location for the host system executing the web browser software and acting as a network terminal.)
- b) storing the terminal identifier in the authorization record; (see Eldridge col. 7, lines 1-16) and
- c) storing, at the network terminal, the terminal identifier. (see Eldridge col. 1, lines 29-42; and col. 6, lines 48-49: “ *The general token 30 includes a Service Host*

*Identifier 32 which identifies a host machine on a network. “ The network address (equivalent to terminal identifier) indicates the network location for the host system executing the web browser software and acting as a network terminal. )*

**Regarding Claim 8 (Currently Amended)**, Eldridge discloses a method according to claim 7, where the authorization record is retrievable by the printer identifier and terminal identifier stored therein. (see Eldridge col. 7, lines 44-54: The token contains an identifier indicating host system with attached item (i.e. document or printer))

**Regarding Claim 10 (Currently Amended)**, Eldridge discloses a method according to claim 1, where the creating step includes the sub-step of:

- a) recording, at the first server, that the authorization identifier has been used; (see Eldridge col. 7, lines 1-16)
- b) the validating step includes the sub-step of rejecting, if the authorization identifier is recorded as having been used, the authorization request. (see Eldridge col. 2, lines 57-60)

**Regarding Claim 11 (Currently Amended)**, Eldridge discloses a method according to claim 1, where the step of storing the authorization identifier at first server includes the sub-step of:

- a) storing expiry information relating to the authorization identifier; (see Eldridge col. 2, lines 58-60; col. 7, line 65 - col. 8, line 3)
- b) wherein the authorization request is rejected if the expiry information indicates that the authorization request id has expired. (see Eldridge col. 2, lines 57-60: “  
*The security information can also include specified conditions that will restrict access to a document. For example, it may include (1) an expiry date beyond which access to the document is no longer granted, ...* . “ Expiration (time period) information is stored as an access parameter for a particular document. If the time period has expired, then access to the document is rejected during the authentication process. )

**Regarding Claim 12** (Currently Amended), Eldridge discloses a method according to claim 2 or claim 3, where the requesting step includes the sub-step of including, in the printing request, the document. (see Eldridge col. 9, lines 35-37: “*The document data are then sent over the network ... , to the workstation 50 which originally received the Print Service token.* “ Document data is transmitted over network to server system printing document. )

**Regarding Claim 13** (Currently Amended), Eldridge discloses a method according to claim 2 or claim 3, where the requesting step includes the sub-step of including, in the printing request, a document identifier of the document. (see Eldridge col. 8, lines 14-26: Document ID is included in the printing request transmitted to server

system.)

**Regarding Claim 14 (Currently Amended)**, Eldridge discloses a method according to claim 13, where the sending step includes the sub-step of retrieving the document using the document identifier. (see Eldridge col. 9, lines 32-34: *“ Using the Document Identifier 46, the document data (electronic file) are retrieved by the file server 52. “* Based on the document ID the actual document can be retrieved from a file server system and transmitted to a print server system. )

**Regarding Claim 15 (Currently Amended)**, Eldridge discloses a method according to claim 14, where the sending step includes the sub-step of formatting the document for printing. (see Eldridge col. 10, lines 7-18; and col. 9, lines 37-40: *“ For example, printer 54 associated with transceiver 22 may be capable of printing only in PostScript.RTM. format; and step s10 therefore included adding parameters to the token designating that the data file sent ultimately to the printer must be converted to PostScript.RTM. format. Following conversion ... , the (converted) document data are sent (step s19) to the printer 54. Upon receiving the document data, the document is printed .... “* The document can require formatting before actual printing at print server system.)

**Regarding Claim 16 (Currently Amended)**, Eldridge discloses a method according to claim 13, where the sending step consists of sending the document identifier to the

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printer. (see Eldridge col. 9, lines 29-34: *"The document data are then sent over the network ... , to the workstation 50 which originally received the Print Service token. "*

Information indicating a specific document (indicated by ID) is sent to the print server system for document printing. )

**Regarding Claim 17** (Currently Amended), Eldridge discloses a method according to claim 1, where the network terminal is a Web browser running on a computer system. (see Eldridge col. 4, lines 67 - col. 5, line 3; col. 5, lines 5-10: *" ... invention has been implemented using conventional web browser software (e.g. Netscape) providing cross-platform communication and document transfer over the internet. However, it will be appreciated that the invention may be implemented using different system configurations: ... PC running Windows. ... , a minicomputer running UNIX ... any suitable processor-controlled network computer. "* A 'network terminal' is designated as a PC system or UNIX system executing a web browser software program. (e.g. Netscape or Internet Explorer) The network terminal system with token server software installed and an attached printer can print document transmitted from other systems in the network. )

### **Conclusion**

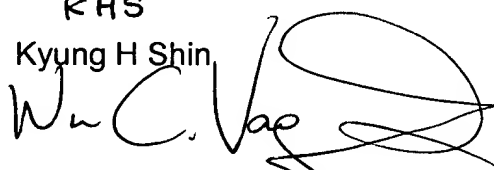
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner  
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KHS  
9/11/2005